

### **REMARKS**

Favorable reconsideration of this application, in light of the following remarks, is respectfully requested.

Claims 1-10, 12, 13, 15-19 and 21-24 are pending. Claims 1 and 21 are amended.

### **INFORMATION DISCLOSURE STATEMENT**

Applicants appreciate the Examiner's acknowledgement of the references filed with the December 11, 2008 IDS, and that the Examiner has included an initialed copy of the 1449 form filed with the December 11, 2008 IDS indicating that the references have been considered.

A supplementary IDS is filed concurrent with this Request for Reconsideration. The IDS dated December 11, 2008, states that "[r]eference JP-A 2003-69278 cited in the Supplementary European Search Report was cited by the Examiner in the Office Action dated September 11, 2008." This is an error; the Examiner previously cited U.S. Patent No. 5,576,710 and not JP-A 2003-69278. However, Applicants note that the Examiner has indicated that the Supplementary European Search Report dated September 29, 2008, which first cited JP-A 2003-69278, has been considered by the Examiner.

### **Rejections under 35 U.S.C. §103(a)**

#### ***Amano in view of Matsuo***

Claims 1-10, 12, 13, 15-19, 21, 22 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Amano ("Investigation on the Matching Characteristics of EM-Wave Absorber Mounted Conductive Patterns[,]," hereinafter "Amano") in view of Matsuo (JP 11-204984, hereinafter "Matsuo"). Applicants respectfully traverse these rejections.

"When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *Ex parte Wada and Murphy* (BPAI Jan. 2008)(citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)).

The Examiner states that,

"Regarding claims 1, 21, and 24, Amano teaches an electromagnetic wave absorber comprising: element receiving means provided with a plurality of conductor elements ("Conductive Patterns: Fig. 2) having predetermined resonant frequencies (ab. Lines 3-5) and including first and second types of conductor elements (cross and square shapes, Figs. 1 and 2), the plurality of conductor elements being arranged spaced away from each other in a direction intersecting an incoming direction of electromagnetic waves (see Fig. 2, esp. "Incident Wave"), and being substantially polygonal (see Figs. 1 and 2), and a loss material ("Lossy Material", Fig. 2) provided close to the element receiving means."

- Office Action, pp. 2-3.

In the Amendment filed December 11, 2008, Applicants argued that Amano in view of Matsuo discloses the use of a single type of element, or if more than one type of element, the elements are not “spaced away” from each other. In response, the Examiner states that,

“The claim does not state, as Applicant appears to be arguing, that the first type of conductor elements are spaced apart from the second type of conductor elements with no overlap between the two. The claim states only that the conductor elements are spaced away from each other, and the Examiner believes that Matsuo’s arrangement satisfies this limitation, with crosses spaced away from other crosses, and squares spaced away from other squares.”

- Office Action, p. 8.

Applicants respectfully disagree.

Applicants have amended claims 1 and 21 without prejudice or disclaimer to the claim language of the Amendment dated December 11, 2008. Although Applicants believe that the language of claims 1 and 21 in the Amendment dated December 11, 2008, adequately distinguishes over Amano in view of Matsuo, claims 1 and 21 are amended for clarification purposes and no additional subject matter is added.

Claim 1 recites, *inter alia*, “the element receiving layer conductor elements being disposed on a surface of the element receiving layer on a side from an incoming direction of electromagnetic waves, to be spaced away from each other[.]” Applicants note that the language “element receiving layer conductor

elements” refers back with antecedent basis to every conductor element of the element receiving layer, regardless of type. Claim 1 makes clear that each of the element receiving layer conductor elements (e.g., every element regardless of type) is disposed on the same surface and spaced away from each other. Therefore, the first type of conductor elements are spaced away from the second type of conductor elements with no overlap between the two.

The Examiner recognizes that, “Amano’s Figures show crosses and squares layered one on top of the other[.]” Office Action, p.8. Accordingly, Amano does not disclose, at least, “the element receiving layer conductor elements being disposed on a surface of the element receiving layer on a side from an incoming direction of electromagnetic waves, to be spaced away from each other[.]” Amano in view of Matsuo cannot repair this deficiency (even if combinable, which is not admitted) and therefore, Amano in view of Matsuo cannot render claims 1 obvious. Applicants respectfully request that the rejections be withdrawn.

Additionally, Applicants argued with respect to Amano in the Amendment dated December 11, 2008, that “[f]or those cases containing a “cross and a square shape,” this refers to a single element for the purpose of matching resonant frequencies, they coexist in the same space in a single layer[.]” or in the alternative, if the shapes in FIG. 1 are separate elements, “Amano does not teach or suggest “spaced away from each other in a direction intersecting an incoming direction of electromagnetic waves[.]”” Amendment filed December 11, 2008, pp. 11-12. The Examiner proposes an entirely different possibility, “that Amano’s

Figures show crosses and squares layered one on top of the other[.]” Office Action, p.8.

However, even taking the Examiner’s statement as true, that rather than being a single element in a single layer, the cross and square of Amano are different elements on different layers, Amano in view of Matsuo still cannot render claim 1 obvious. Claim 1 recites, *inter alia*, “an element receiving layer provided with a first type and a second type of conductor elements[.]” emphasis added. Claim 1 further recites, “the element receiving layer conductor elements being disposed on a surface of the element receiving layer[.]” Therefore, claim 1 cannot read on Amano because claim 1 recites a layer with at least two types of conductor elements on a surface of the element receiving layer, while Amano is “layered” (e.g., the elements of Amano are on more than one layer).

Whether Amano discloses a layer with a single element as Applicant argues, or different layers with different types of elements as the Examiner alleges, Amano does not disclose a layer with at least two types of conductor elements on a surface of the layer, as recited by claim 1. Amano in view of Matsuo cannot repair this deficiency (even if combinable, which is not admitted) because Matsuo does not disclose more than one type of conductor element. Because the Examiner interprets the figures of Amano as having separate layers with different types of conductor elements, Amano in view of Matsuo cannot render claim 1 obvious.

For at least the reasons stated above, Applicants request the rejection to claim 1 be withdrawn. Claims 2-10, 12, 13, 15-19, 23 and 24 are patentable at least by virtue of their dependency on claim 1. Claim 21 is patentable for reasons at least similar to those stated above for claim 1. Claim 22 is patentable at least by virtue of its dependency on claim 21.

***Okano in view of Matsuo***

Claims 1-7, 10, 12-13, 15-16, 18-19, and 21-24 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Okano (JP 2004-140194, hereinafter "Okano") in view of Matsuo. Applicants respectfully traverse these rejections.

Applicants respectfully point out to the Examiner that Okano, listed by the Examiner on the form PTO-892, is a Japanese Patent Document dated May 10, 2004. The present application is a national stage entry of international application PCT/JP2004/002503 having an International filing Date of March 1, 2004. Okano cannot qualify as prior art under any section of 35 U.S.C. §102 at least for the reason that Okano does not predate the present application's filing date and therefore may not qualify as a reference. For example, see the Continuity Data tab in PAIR, associated documents in the present application's file wrapper and MPEP 1893.03(b). Accordingly, Applicants request that the rejections to claims 1-7, 10, 12-13, 15-16, 18-19, and 21-24 be withdrawn.

## **CONCLUSION**

Accordingly, in view of the above remarks, reconsideration of the rejections and allowance of each of claims 1-10, 12, 13, 15-19 and 21-24 in connection with the present application is earnestly solicited.

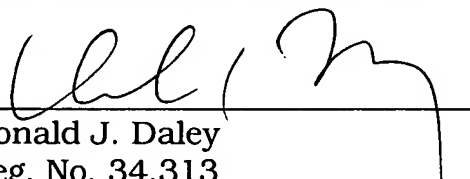
Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a one (1) month extension of time for filing a reply to the outstanding Office Action and submit the required extension fee herewith.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Andrew M. Waxman, Reg. No. 56,007, at the number of the undersigned listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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